

In re Appln. Of: Thomas E. Valiulis
Application No.: 10/802,983

REMARKS

On August 4, 2006, an Advisory Action was issued by the Patent Office indicating that the Response to Office Action dated July 18, 2006, would not be entered. Therefore, the Applicant hereby files a Request for Continued Examination pursuant to 37 C.F.R. §1.114.

The Applicant requests that the amendments noted in this presently filed Submission With Request For Continued Examination be entered and the remarks relating to those amendments, as detailed below, be considered. The Patent Office is instructed not to enter the amendments in the un-entered Response to Office Action dated July 18, 2006, pursuant to MPEP §706.07(h)V.

The Office Action and cited references have been reviewed. Claims 1-4, 9-11 and 29-35 are rejected. Claims 5-8 and 12-16 have been withdrawn. Claims 1, 2, 4, 6, 29, 30 and 32 have been amended. Support for the amendments is found generally within the application and specifically as noted below. Claims 17-28 have been cancelled. New claims 38-45 have been added. No new matter has been added. Consideration of the pending claims is respectfully requested.

Rejection under 35 U.S.C. §112

The Office Action has rejected claims 1-4 and 9-11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In particular, the Office Action has indicated that there is an inconsistency between the preamble and certain portions of claim 1.

Claim 1 has been amended to clarify the Applicants' intent to claim the subcombination of "an apparatus." It is noted that the merchandise does assist in defining the arrangement or location of the reduced friction layer. Therefore, it is respectfully submitted that the rejection of claim 1 be withdrawn.

Rejection under 35 U.S.C. §102

The Office Action has rejected claims 1, 9-11, 29 and 33-35 under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. App. No. 6,484,891 to Burke (hereinafter "Burke"). In response, independent claim 1 has been amended to incorporate some of the subject matter of claims 2 and 4 as a Markush group and to clarify that the reduced friction layer is a cured silicon that has been cured by ultraviolet (UV) light. Likewise, independent claim 29 has

been amended to incorporate some of the subject matter of claims 30 and 32 as a Markush group and that the reduced friction layer is a cured silicon that has been cured by ultraviolet (UV) light.

As amended, claim 1 includes, *inter alia*, that the reduced friction layer is “selected from the group consisting of a fluoropolymer coating and a silicon coating that has been cured by ultraviolet (UV) light.” Likewise, as amended, claim 29 includes, *inter alia*, that the reduced friction layer is “selected from the group consisting of a fluoropolymer coating and a silicon coating that has been cured by ultraviolet (UV) light.” The Office Action has, on page 5, conceded that Burke does not teach these limitations. As such, the rejection of claims 1, 9-11, 29 and 33-35 under 35 U.S.C. §102(e) is now moot. Therefore, it is respectfully submitted that the claims are allowable.

Rejection under 35 U.S.C. §103

The Office Action has rejected claims 2, 3, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Burke in view of U.S. Pat. No. 5,242,164 to Nicoll (hereinafter “Nicoll”). Claim 2 has been amended and some of the subject matter thereof incorporated into claim 1. Therefore, the following remarks will reflect that amendment.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. MPEP §2142-2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

According to MPEP §2143.01, there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

Here, Burke employs a silicon spray to solve the problem of increasing lubrication between moving components (i.e., between the pusher and its support). See Col. 9, lines 14-16. In contrast, the present invention is directed toward decreasing the coefficient of friction between the merchandise and the shelf support surface. The Burke reference discloses and teaches a specific way and very specific material to increase lubrication between moving components of a shelf, not between merchandise and a shelf. The secondary reference, namely Nicoll, relates to a game and has nothing to do with self-facing force. As a result, changing the purpose and material of Burke for the merchandise interface reasons of the present invention considering the game teachings of the Nicoll reference can only be done using improper hindsight and the inventors' concept disclosed in the application which is reducing the coefficient of friction between the merchandise and the shelf to lower the self facing force.

Indeed, it is quite telling that Applicants' low friction material as disclosed and explicitly claimed are not the same and do not overlap the disclosed materials of Burke. Burke relates to standard lubrication where the same sliding components contact each other as they move back and forth and transfer the lubrication back and forth between themselves as they do so. In contrast, the components of the present application, namely the shelf and the merchandise, do not readily transfer the reduced friction layer between the two components. The reduced friction layer materials claimed in the independent claims are of a more permanent nature and are not meant to flow or transfer from the shelf to the merchandise. In fact, the merchandise should be able to be pulled from the pusher system without having the lubrication come with it. Using the lubrication material of Burke would likely deplete the surface immediately.

In addition to the fact that different problems are being solved by the two references, neither Burke or Nicoll, either expressly or impliedly, teaches or suggests a combination of the two references. Simply put, Nicoll relates to a top sliding surface and not lubricating moving components of a shelf assembly. Therefore, it is respectfully submitted that the combination of Burke with Nicoll is improper. For these reasons alone, the obviousness rejection of claims 3, 30 and 31 should be withdrawn. Also, claim 1, which includes some of the subject matter of amended claim 2, would not be obvious.

From the foregoing, it is respectfully submitted that one skilled in the art would not look to Nicoll in changing the lubricating materials of Burke unless one had the knowledge of the present Applicants' teachings. This is improper hindsight. Therefore, Nicoll is not a

proper reference to combine with Burke and the obviousness rejection of claims 3, 30 and 31 should be withdrawn. Also, claim 1, which includes some of the subject matter of amended claim 2, would not be obvious.

The Office Action has further rejected claims 4 and 32 under 35 U.S.C. §103(a) as being unpatentable over Burke in view of U.S. Pat. No. 6,218,017 to Yamashita et al. (hereinafter “Yamashita”). Claim 4 has been amended and some of the subject matter thereof incorporated into claim 1. Therefore, the following remarks will reflect that amendment.

Yamashita describes an invention related to containers for electronic parts. See Col. 1, lines 5-14. Yamashita briefly mentions using an ultraviolet-setting antistatic agent in or on the covers for the containers, which is well known in the electronics industry as a way to protect the sensitive electronic components held therein from electrostatic discharge. Antistatic agents are compounds used for the treatment of materials or their surfaces in order to reduce or eliminate buildup of static electricity. In contrast, a reduced friction layer is one which reduces the force that opposes the relative motion between two surfaces in contact. Therefore, an antistatic agent is completely different from a reduced friction layer. Further, the problem of static electricity is not mentioned in the present application. This different purpose of Yamashita, which is entirely unrelated to Burke, is inappropriately used in an effort to find the present invention obvious.

For the same reasons as noted above, Yamashita would not be combined with Burke by one of ordinary skill in the art. The problems being solved by the two references, as well as the field of art from which the references come, are completely different. Again, one would only get the idea of using different material of Yamashita only if it had Applicants’ invention and teachings in mind. This is improper hindsight. As a result, the obviousness rejection of claim 32 should be withdrawn. Also, claim 1, which includes some of the subject matter of amended claim 4, would not be obvious.

New Claims

The Applicants have added new claims 36-45. New claims 36 and 37 are directed to a reduced friction layer that is permanently affixed to the support surface. Burke, on the other hand, relies on a silicon spray. Because the silicon is applied by spraying, the silicon is not permanently affixed to the support surface. In fact, the silicon spray can be transferred between components moving relative to one another as well as having the ability to run, drip or otherwise move on the particular component to which it is directly applied.

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New claims 38 and 39 affirmatively recite the retail merchandise. Therefore, the retail support structure and the reduced friction layer are claimed in combination with the retail merchandise. These claims focus on the fact that the reduced friction layer reduces the drag on the retail merchandise. In other words, the reduced friction layer decreases the drag between the retail merchandise and the reduced friction layer.

New claims 40 and 41 indicate that the reduced friction layer is a fluoropolymer tape. Such a tape is not taught or suggested by Nicoll or the other references. New claim 42 also affirmatively recites two or more pieces of the retail merchandise and that the reduced friction layer is permanently affixed to the support surface. New claims 43 and 44 recite specific types of a reduced friction layer while new claim 45 focuses on the reduced drag force on the retail merchandise provided by the reduced friction layer. It is respectfully submitted that none of these limitations is found in the cited references.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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